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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,409	04/12/2000	Gregory M. Finn	FINN-002	5799

7590 07/15/2005

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EXAMINER
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GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/547,409

Applicant(s)

FINN ET AL.

Examiner

Clement B. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-21, has been deleted and claims 22-42 has been added.

**Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-42, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 22-42, do not recite any structure or functionality to suggest that a computer performs the recited claims. Thus, claims 22-42, are rejected as being directed to non-statutory subject matter.

Applicant's is advised to imbed a computer in the body of the claims.

**Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international

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application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 22-42, are rejected under 35 U.S.C. 102(e) as being anticipated by Lupien et al (Hereinafter Lupien U.S Patent 5, 101, 353).

As per claim 22, Lupien discloses an investment vehicle for enabling a plurality of investors to selectively buy and sell interests in each of a plurality of different individual securities traded on at least one financial market, comprising:

a plurality of accounts for which the plurality of investors can buy and sell the interests in the plurality of securities, each of the accounts corresponding to at least one of the plurality of investors; and a graphical user interface.( see column see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35) and wherein, for each of the plurality of individual securities, interests in the security which are bought or sold by the at least one investor can correspond to a selected fractionalized market unit of the security (see column see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35) and wherein the investment vehicle enables the investor to transmit to the investment vehicle orders to buy and sell the interests in the plurality of securities, each of the orders can include a plurality of limit requests, and each of the plurality of limit requests is a request to buy or sell interests in one or more of the plurality of securities upon the happening of a specific event or condition.(Note abstract and see Fig: 2-6 and column see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 23, Lupien discloses wherein at least one of the plurality of limit requests is a request to buy or sell interests in more than one of the plurality of securities upon the happening of a specific event or condition. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and

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column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 24, Lupien discloses wherein the event or condition can relate to at least one of a market index, a change in a portfolio total value, a change in a portfolio weighted average value, a corresponding one of the plurality of accounts as a whole, and a corresponding one of the investors. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 25, Lupien discloses wherein the event or condition can relate to something or someone unrelated to corresponding ones of the securities, a corresponding one of the accounts, or a corresponding one of the investors. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 26, Lupien discloses wherein the investment vehicle enables the investors to organize, using the graphical user interface, holdings in the corresponding accounts into one or more groups that can be defined by the investors to suit the investors' portfolio structuring desires. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 27, Lupien discloses wherein the investor can specify an allocation factor for each security and for each group included in the account, the allocation factor for a group specifying a percentage of a total amount to be used to purchase interests in securities for the account, and the allocation factor for a security specifying a percentage of a total amount to be to be used to purchase interests in securities for the group in which the security is located, or if the security is not in a group, a percentage of the total amount to be used to purchase interests in securities for the account. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

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As per claim 28, Lupien discloses wherein each of the investors is charged a fixed commission for each order that is accepted and acted upon by the investment vehicle on behalf of the investor, the commission being determined irrespective of the number of different securities that are involved with the order, the number of shares of each security involved in the order, the value of the investor's portfolio, and the fact that the order may include requests to both buy and sell interests in securities. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 29, Lupien discloses wherein each of the securities involved in the order is allocated a percentage of the commission charged, the percentage being derived by dividing the value of the interest of each security purchased or sold by the total value of the interests of all the securities purchased or sold. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 30, Lupien discloses wherein each of the investors is charged a fixed commission for each order that is accepted and acted upon by the investment vehicle on behalf of the investor, the commission being determined irrespective of the number of shares of each security involved in the order, the value of the investor's portfolio, and the fact that the order may include requests to both buy and sell interests in securities. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 31, Lupien discloses wherein each of the securities involved in the order is allocated a percentage of the commission charged, the Percentage being derived by dividing the value of the interest of each security purchased or sold by the total value of the interests of all the securities purchased or sold. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and

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column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 32, Lupien discloses wherein the graphical user interface provides the investors with dynamically re-configurable building blocks, each representing at least one of a security and a group of securities held in a corresponding one of the accounts, to enable the investors to build, re-configure and manage the accounts in a visually intuitive manner and to visually offer the investors portfolio information for the accounts. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 33, Lupien discloses wherein the investment vehicle enables the investors to organize, using the graphical user interface, holdings in the corresponding accounts into hierarchical, multi-tiered portfolio structures of one or more groups and subgroups that can be defined by the investors to suit the investors' portfolio structuring desires. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 34, Lupien discloses wherein for each account, the corresponding investor can specify an allocation factor for each security, for each group and for each sub-group included in the account, the allocation factor for a group specifying a percentage of a total amount to be used to purchase interests in securities for the account in which the group is located, the allocation factor for a sub-group specifying a percentage of a total amount to be used to purchase interests in securities for the group in which the sub-group is located (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35) and the allocation factor for a security specifying a percentage of a total amount to be used to purchase interests in securities for the group or sub-group in which the security is located, or if the security is not in a group or sub-group, a percentage of the total amount to be used to purchase interests in securities for the account in which the

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security is located. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 35, Lupien discloses wherein the investor can extend the account portfolio structure such that subgroups can themselves have subgroups. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 36, Lupien discloses where individual securities can reside at any tier level alongside groups and subgroups within the account portfolio. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 37, Lupien discloses wherein the investors can modify at least one of their corresponding account portfolio securities, groups, subgroups and allocation factors at any time after account set-up. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 38, Lupien discloses wherein the graphical user interface provides the investors with dynamically re-configurable building blocks, each representing at least one of a security, a group of securities, and a subgroup of securities held in a corresponding one of the accounts, to enable the investors to build, re-configure and manage the accounts in a visually intuitive manner and to visually offer the investors portfolio information for the accounts. (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 39, Lupien discloses wherein the investor can specify for holdings in a corresponding one of the accounts percentages of the total value of the account to which the values of the holdings should correspond (see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8



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lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35) and wherein the investment vehicle reviews the investor's account and compares the holdings in the account with the specified percentages, and upon finding a discrepancy between the holdings and the specified percentages, which discrepancy is above a level set by the investor, notifies the investor of the discrepancy.(see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 40, Lupien discloses wherein the investor can specify for securities and groups of securities in a corresponding one of the accounts percentages of the total value of the account to which the values of the holdings should correspond, and wherein the investment vehicle review the investor's account and compares the holdings in the account with the specified percentages, and upon finding a discrepancy between the holdings and the specified percentages, which discrepancy is above a level set by the investor notifies the investor of the discrepancy.(see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 41, Lupien discloses wherein the investor can specify for securities, groups of securities, and subgroups of securities in a corresponding one of the accounts percentages of the total value of the account to which the values of the holdings should correspond, and wherein the investment vehicle review the investor's account and compares the holdings in the account with the specified percentages, and upon finding a discrepancy between the holdings and the specified percentages, which discrepancy is above a level set by the investor, notifies the investor of the discrepancy.(see column 3 lines 46-68 and column 4 lines 1-41 and column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 an column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

As per claim 42, Lupien discloses wherein the investors can modify at least one of their corresponding account portfolio securities, groups, and allocation factors at any time after account set-up. (see column 3 lines 46-68 and column 4 lines 1-41 and

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column 5 lines 63-68 and column 6 lines 1-68 and column 7-8 lines 1-68 and column 9 lines 1-33 and column 15 lines 38-68 and column 16 lines 1-35).

### CONCLUSION

#### Response to Arguments

5. Applicant's arguments filed on 4/20/2005 have been fully considered but are moot in view of new grounds of rejections.

6. In response to applicant's arguments regarding Keiser and Wallman.

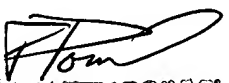
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

June 17, 2005

  
CLEMENT B. GRAHAM  
PRIMARY EXAMINER  
AU 3628